



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,935	11/30/2000	Stephane Bouet	017.39361X00	2892

20457 7590 11/29/2004

ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/725,935

Applicant(s)

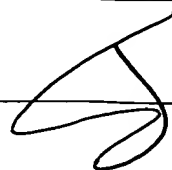
BOUET ET AL.

Examiner

James A. Reagan

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, and 8-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the amendment filed on 25 October 2004.
2. Claims 1, 5, 15, and 19-24 have been amended.
3. Claims 32-40 have been added.
4. Claims 1, 3-6, and 8-40 have been examined.
5. The rejections of claims 1, 3-6, and 8-31 have been updated to reflect newly-added limitations.
6. The rejections of claims 32-40 are original.

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 6-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter in view of Martineau, US Patents No. 5,892,900, and No. 5,915,226 respectively.

#### **Claim 1:**

Both Martineau and Ginter disclose the following limitations (see at least Martineau: Abstract; Figs 1-3, associated description; Col 4, lines 17-38. See at least Ginter Abstract; Figs 1-2A, 7, 71, associated description; Col 40, line 62-Col 42, line 3: "...support smart cards..."):

(a) storing [authorizing] information in a memory module separate from and releasably attachable to at least the second terminal device (Martineau: Fig 1, associated text: Ginter. C41, L1: "smart cards can dock with an established terminal"), the [authorizing] information defining what electronic content is able to be transferred, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred from the first terminal device to the second terminal device;

(b) attaching the memory module to the second terminal device (see above citations),

(c) while the memory module is attached to the second terminal device, reading the [authorizing] information from the memory module into the second terminal device (Martineau: C4, L 17-38; Ginter: C41, 1-5-7: 'the VDE card and the terminal can securely exchange information relating to a transaction);

(d) comparing the [authorizing] information in the second terminal device with [authorizing] information included with the electronic content (see above citations); and

(e) if the [authorizing] information in the second terminal device compares favorably with the [authorizing] information included with the electronic content, transferring the defined electronic content from the first terminal device to the second terminal device according to the tailoring information (see above citations).

Martineau does not specifically recite the term "tailoring information." However Ginter teaches that control and access codes may be stored on the smart card defining what electronic content may be transferred, what content can be transferred, if it can be further transferred to a third party, if it can be copied, edited, or have its rules of control and access changed prior to further transfer, when the content can be transferred, the period of time during the content may be accessed, what payment is due for accessing the content, etc., etc. The control and access code may also include, as appropriate, cryptographic keys and digital signatures, for appropriate authentication, verification, and authorization of both parties to the transaction (see both Martineau and Ginter citations above). In addition, see at least

Cols 299 - 302 of Ginter, where an example of "Secure Document Management" is illustrated. In this section, Ginter teaches that his invention may control:

1. the use and distribution (i.e. transfer) of electronic content (C299, L14-33: "control access, distribution, and/or other rights to documents"; "control how [others] may use, including change, briefs"; "electronically file briefs").

2. the access, use, and distribution permissions granted to each individual or node in the system's architecture (C299, L42-59: "only those members ... who possess a VDE instance, an appropriate [permissions control information set] PERC, and the VIDE object that contains the desired document, may use the document.").

3. the secure transmission of such electronic content from one participant to another, using Ginter's system (C302, L3-15).

Applicant is also directed to other 'Examples' illustrated by Ginter, especially the "VDE Protected Content Depositories" section (Col 307-32). As can be seen from this and the above citations, it is clear that Ginter's system allow every single instance of "tailoring information" required to tightly control who gets to access, use, transfer, and otherwise modify electronic content, with the corresponding auditing, reporting, and billing capabilities as well. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Ginter's teachings to a wireless system as disclosed by Martineau in order to provide convenient, safe, secure, versatile, and portable means for delivering and distributing electronic content, as recited in claim 1.

With regard to the newly-added limitation of if the tailoring information parameters do not match, transfer of the electronic content from the first terminal to the second terminal is not permitted, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to prevent transfers of the data to prevent unauthorized use.

**Claims 15 and 16:**

Both Martineau and Ginter, as shown, disclose:

- an element for transferring selected electronic content over the wireless connection according to predetermined [authorizing] information defining electronic content eligible to be transferred from the element, a period of time during which the defined electronic content is able to be transferred and whether the defined electronic content can be transferred by a first terminal device to a further terminal device (see above citations);
- a terminal device for receiving electronic content over the wireless connection (see above citations);
- a memory module for storing the [authorizing] information, the memory module being separate from and releasably attachable to the first terminal device (see above citations);
- attaching means for attaching the memory module to the first terminal device (see above citations);
- the first terminal device being adapted to read the [authorizing] information from the memory module and to transmit the [authorizing] information to the element over the wireless connection (see above citations), and
- the element being adapted to transfer electronic content to the first terminal device over the wireless connection according to the [authorizing] information (see above citations).

Using the same obviousness and motivation analysis as for claim 1, Ginter in view of Martineau disclose all the limitations of claim 15.

**Claim 3:**

Ginter in view of Martineau discloses all the limitations of claim 1. Ginter further discloses before step (d) the method further comprises the additional step of transmitting the [authorizing] information from the second terminal device to a third device (Ginter: see above citations; Figs 77-78, associated description) over a radio frequency link (Ginter Col 251, lines 4-6); and step (e) comprises transferring the electronic content to the second terminal device over the radio frequency link (see above citations).

**Claim 6:**

Ginter in view of Martineau discloses all the limitations of claim 3. Ginter further discloses (Col 2: 'Controlling Electronic Content'; Col 2, line 46: "...automatically enforce agreed upon rights and obligations..."). Ginter's system also has the capability to determine if data has been stored within the local memory storage and avoid having such data downloaded (see Ginter citations above).

**Claim 8:**

Ginter in View of Martineau discloses all the limitations of claim 1. Ginter further discloses (see above Ginter citations) the electronic content includes copies of a periodically published item.

**Claim 9:**

Ginter in view of Martineau discloses all the limitations of claim 1. Ginter further discloses (see above Ginter citations) the memory module is an integrated circuit card.

**Claim 10:**

Ginter in view of Martineau discloses all the limitations of claim 9. Martineau further discloses (Martineau: Col 4, lines 17-38) transferring a serial number of the integrated circuit card to the first terminal device, checking the validity of the integrated circuit card based on the serial number. It

would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined this authentication method as taught by Martineau into the system and method disclosed by Ginter, in order to provide a secure, portable system for delivering content over a wireless network. Such a system would have included the limitations recited above, as well as in response to a determination that the integrated circuit card is valid, transferring the electronic content to the second terminal device.

**Claim 11:**

Ginter in View of Martineau discloses all the limitations of claim 1. Ginter further discloses (see above Ginter citations; Ginter: starting at Col 8: "Electronic Content") electronic content is electronic goods.

**Claim 12:**

Ginter in view of Martineau discloses all the limitations of claim 11. Ginter further discloses (see above Ginter citations) the electronic content is at least one selected from the group consisting of movies, music, games, electronic magazines, periodicals, newspaper, and television news.

**Claim 13:**

Ginter in view of Martineau discloses all the limitations of claim 11. Ginter further discloses (see above Ginter citations) the electronic content includes a series of movies.

**Claim 14:**

Ginter in view of Martineau discloses all the limitations of claim 1. Ginter further discloses (see above Ginter citations) the electronic content is in the form of electronic services.



**Claim 17:**

Ginter in view of Martineau discloses all the limitations of claim 16. Ginter further discloses the memory module is an integrated circuit card (see above Ginter citations).

**Claim 18:**

Ginter in view of Martineau discloses all the limitations of claim 17. Ginter further discloses (see above Ginter citations; especially Col 41, line 17: The card can be used as an "electronic wallet" and contain electronic currency as well as credit provided by a clearinghouse).

**Claims 32-34:**

With regard to the limitation of the tailoring information specifies a number of times the first terminal device may transmit the electronic content to other terminal devices, see Ginter at least column 58, lines 64-67.

9. Claims 4-5 and 19-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter in view of Martineau and further in view of Nokia Mobile Phones Limited Nokia, International Patent Publication No WO/00118025.

**Claim 4:**

Ginter in view of Martineau discloses all the limitations of claim 3. Ginter does not specifically disclose the radio frequency link is a short-range communication radio frequency link. Nokia, however, discloses a portable communication method and system comprising a portable communications device capable of establishing a short-range, low power radio frequency (RF) link with a local terminal and causing data to be transmitted between them (Nokia. Abstract; Figs 1-3, associated description; Page 1, lines 1-24). It would have also been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF

communication method to Ginter's invention, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users.

**Claim 5:**

Ginter in view of Martineau and Nokia discloses all the limitations of claim 4. Ginter further discloses (see above Ginter citations):

- sending an inquiry from the second terminal device to the third terminal device;
- sending a response to the inquiry from the third terminal device to the second terminal device;
- transmitting the [authorizing] information to the third terminal device, and
- transferring the electronic content from the first terminal device to the third terminal according to the [authorizing] information received from the second terminal device.

Nokia discloses causing the first terminal device to enter the coverage area of the second terminal device (Nokia: Page 1, lines 21-23; Page 2, lines 4-28). Therefore it would have also been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to Ginter's invention, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users.

**Claim 19:**

Both Martineau and Ginter (see above citations; Ginter Col 40, line 62 - Col 42, line 3: "...support smart cards...") disclose:

- a storage device for storing [authorizing] information, the [authorizing] information defining specific electronic content that the storage device authorizes as being transferable to the terminal device, a period of time during which the defined electronic content is able to be transferred and

whether the defined electronic content can be transferred by the terminal device to a further terminal device;

- an interface for mechanically and electrically coupling the storage device to the terminal device, the interface allowing releasable attachment of the storage device by a user to the terminal device to bring the storage device into mechanical and electrical contact with the terminal device;
- means for reading the [authorizing] information from the storage device into the terminal device when the storage device is in mechanical and electrical contact with the terminal device,
- Neither Martineau nor Ginter specifically disclose the use of a transceiver.

Nokia discloses a portable communication method and system comprising a portable communications device capable of establishing a short-range, low power radio frequency (RF) link with a local terminal and causing data to be transmitted between them, using transceivers located in each such device (Nokia: Abstract; Figs 1-3, associated description; Page 1, lines 1-24). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to either Martineau's or Ginter's inventions, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users.

**Claims 20-22:**

Using the obviousness and motivation analyses and the citations already made for claims 1, 15, 16, and 19, Ginter in view of Martineau disclose the limitations of claims 20-22. In addition, Nokia discloses a portable communication method and system comprising a portable communications device capable of establishing a short-range, low power radio frequency (RF) link with a local terminal and causing data to be transmitted between them (Nokia: Abstract; Figs 1-3, associated description; Page 1, lines 1-24). Nokia does not use the term "access point". However Nokia does disclose that a device

within their system may be used as a wireless 'gateway' for another device to access to a Public Telephone Switching Network (PTSN) (Page 5, lines 13-18, Fig 3). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have configured any of Nokia's terminals with the proper software and hardware to make them into "access points", so that portable devices may access the network when coming into proximity of such devices. Therefore it would have also been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to either Martineau's or Ginter's inventions, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users.

**Claims 23-24:**

Using the obviousness and motivation analyses and the citations already made for claims 1, 15, 16, and 19, Ginter in view of Martineau and Nokia disclose all of the limitations of claims 23-24.

**Claim 25:**

Both Martineau and Ginter (see above citations; Ginter Col 40, line 62 - Col 42, line 3: "...support smart cards...") disclose the limitations of claim 24. Martineau and Ginter do not specifically disclose step (e) comprises transferring the electronic content in a push-mode. However, push and pull modes for delivering content are well-known techniques for delivering digital content over a communications network. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to add this feature to the system, in order to serve targeted content such as news updates or promotional material to authorized users, thus avoiding the need for the users to actively get online and search for content themselves.

**Claim 26:**

Ginter in view of Martineau and Nokia disclose all the limitations of claim 24. Nokia (Page 1) discloses the Bluetooth wireless protocol as a popular wireless protocol. It would have been obvious to one ordinarily skilled in the art at the time the invention was made to add this feature to the system, in order to provide a versatile, well supported wireless transport protocol, which can then be shared between many different devices and carriers.

**Claims 27:**

Ginter in view of Martineau and Nokia disclose all the limitations of claim 24. Nokia, in at least page 5, lines 25-28 discloses a second terminal device. It would have been obvious to one ordinarily skilled in the art at the time the invention was made to add this feature to the system, in order to provide a versatile, well supported wireless transport protocol, which can then be shared between many different devices and carriers.

**Claims 28-31:**

Using the obviousness and motivation analyses and the citations already made for claims 1, 15, 16, 19, and 27, Ginter in view of Martineau and Nokia disclose all of the limitations of claims 28-31.

**Claims 35-40:**

With regard to the limitation of the tailoring information specifies a number of times the first terminal device may transmit the electronic content to other terminal devices, see Ginter at least column 58, lines 64-67.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including

After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

23 November 2004

